



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,890	08/10/2001	Gerald Jacino	1714-40	4787

7590

09/13/2004

M. Arthur Auslander, Esq.
Natter & Natter
25 West 43rd Street
New York, NY 10036

EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/927,890		JACINO ET AL.	
	Examiner		Art Unit	
	Gladys J Piazza Corcoran		1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004 and 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

It appears as though Applicant may be having difficulty keeping with the original language of the original Specification. This seems to be a reminder of how important it is to write a clear and concise and detailed original Specification. Some of Applicant's amendments to the claims that do not follow the original language of the Specification appear to not affect the patentability of the claims, are not supported by the original Specification, are deemed unnecessary, and introduce additional 35 USC 112 rejections. It is suggested to keep the claim language as originally disclosed in the original Specification. Additionally, Applicant has not provided either amendments to the claims and/or Specification or arguments for traversing many of the previous rejections. The Examiner has taken the time to provide detailed suggestions for overcoming many of the numerous rejections below. It would be appreciated if Applicant would also be as thorough in the Responses to the Office Actions. It is noted that future Responses to Office Actions without proper responses to all the rejections will be considered Non-Responsive as applicable (see MPEP § 714.02, 714.04, 2163.06).

Specification

1. The amendment filed May 13, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. On page 7, in the fourth paragraph, "It should be noted, from Fig. 5 and Fig. 6, that in addition to the clear portion 15, the cut panel 19 includes top and side peripheral borders which are free of lines of ridges." While it may be clear in figures 10 and 11 that the areas of the peripheral border surrounding the clear portions 32 and 42 are free of lines of ridges, there is no support in the original Specification that would suggest to one of ordinary skill in the art that Applicant had possession of top and side peripheral borders free of lines of ridges.

b. On page 8, in the third paragraph, "The flexibility of the cut panel 19 at ambient temperatures enables an in situ liquid tight seal effecting the perfect repair." While the change of "type" to "tight" is not considered new matter, the additions of the limitations "at ambient temperatures" and "in situ" are considered new matter. There is no support in the original Specification that would suggest to one of ordinary skill in the art that Applicant had possession of the flexibility of the panel being at ambient temperature or an in situ repair.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The newly recited claims 9-20 are replete with newly recited claim limitations that lack antecedent basis in the Specification. It is suggested to amend the Specification to provide antecedent basis for the claim limitations without adding new matter.

a. For example, claims 9 and 17 recite the limitation that the ridges extend "into the thickness of the panel from the inner surface toward the outer surface." This limitation has support in the originally filed figure 2, however antecedent basis should be provided in the Specification. The Specification should recite --the ridges extend into the thickness of the panel from the inner surface toward the outer surface in Figure 2--.

b. Claim 12 recites, "a second plurality of intersecting lines of ridges extending from the inner surface toward the outer surface, the second plurality of lines of ridges forming a grid pattern on the inner surface." The original Specification provides support for these limitations by reciting on page 7 that a selection of round cuts 43-46 are provided on repair panel 40 and the figure 11 showing the cuts 44 and 43 with additional grid patterns to the pattern 41, however antecedent basis for this claim language should be provided in the Specification. For example, the suggested amendment above [--the ridges extend into the thickness of the panel from the inner surface toward the outer surface in Figure 2--] would also overcome this objection.

Claim Objections

3. Claim 23 is objected to because of the following informalities: Claim 23, line 3 should recite, "having a plurality of". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for automobile lens or bulb housings, does not reasonably provide enablement for all lens or bulb housings. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The Original Specification only discloses repair of automobile lens or bulb housings. There is no suggestion to one of ordinary skill in the art that Applicant had possession at the time of invention of repairing all types of lens or bulb housings. Therefore the scope of the claims are broader than that disclosed and enabled by Applicant's original Specification. It is suggested, as suggested in the prior Office Action, to replace "automobile" to all the claims such that the claims recite --automobile lens or bulb housing-- as originally claimed.

6. Claims 9-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Again as stated in the Prior Office Action, the claims are replete with newly added limitations and new matter. It is suggested to accompany future amendments with an indication of where support can be found in the original Specification for any and all newly added limitations.

a. Claim 17 recites, "having a substantially uniform thickness". There is no support in the original Specification for the repair panel having a substantially uniform thickness. It is suggested to delete this recitation.

b. Claims 9 and 17 recite, "suitable for withstanding external exposure to the atmosphere." There is no support in the original Specification for this limitation. It is suggested to delete this recitation.

c. Claims 9 and 17 recite "a substantially flat inner surface." There is no support in the original Specification for this limitation. It is suggested to delete this recitation.

d. Claim 9 recites, "including a plurality of elongate gasket strips of sufficient length to overlie a peripheral border of the inner surface." While there is disclosure of a method of applying multiple gasket strips around the border of a cut part of the repair panel, there is no disclosure in the original Specification for providing enough strips to overlie the peripheral border of the inner surface of the repair panel in a kit. It is suggested to delete this recitation.

e. Claim 9 recites, "whereby the panel may be flexed in situ to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area and sealed by the gasket strips to the exterior surface of the lens or bulb housing." While the Specification discloses that the repair panel is cut, the gasket strips are applied to the cut panel, release sheets on the gasket strips are removed to engage the cut panel over the damaged area, and the flexibility of a cut panel enables a liquid type seal on page 19, there is no disclosure for the limitations as currently recited. It is

suggested to recite --the flexibility of the panel enables a seal over a damaged area of a curved automobile lens or bulb housing--.

f. Claim 11 recites that "the peripheral border is free of lines." While the Specification discloses a clear portion border 15 (it is not along the peripheral border) and clear portions 32 and 42 (they are not along the entire peripheral border) (see figures 10 and 11). There is no support in the original Specification for the entire peripheral border to be free of lines. It is suggested to recite --a portion of the peripheral border is free of lines--, and to include a similar recitation in the Specification to provide for antecedent basis.

g. Claim 15 recites that "a first plurality of equidistantly spaced parallel lines and a second plurality of equidistantly spaced parallel lines extending perpendicular to the first plurality." The original Specification does disclose ridges that form a grid, however there is no disclosure as to the relationship between the spacing of the lines (equidistant).

h. Claim 17 recites, "a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto." The Specification discloses providing multiple gaskets with adhesive layers around a periphery of a patch to form a border with release strips on each strip and a separate panel where an adhesive layer 48 is on the back of the panel covered with a release paper 47 (page 8). However, there is no disclosure of a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto. It is suggested to clarify which embodiment is being claimed. For example, --an adhesive layer on the inner surface of

the panel-- or --adhesive layers of gaskets provided on an inner surface of the panel along the periphery of the panel--.

i. Claim 17 recites, "whereby the panel may be flexed in situ to conform to the contour of the exterior surface of the lens or bulb housing surrounding the damaged area and sealed to the exterior surface of the lens or bulb housing by applying a compressive force to the outer surface of the panel." While the Specification discloses that the release sheets are removed to engage the cut panel over the damaged area, and the flexibility of a cut panel enables a liquid type seal on page 19, there is no disclosure for the limitations as currently recited. It is suggested to recite --the flexibility of the panel enables a seal over the damaged area of a curved automobile lens or bulb housing--.

j. Claim 19 recites, "the border of the inner surface of the panel surrounding the periphery is free of the grid pattern." As discussed above, there is no disclosure in the Specification for these limitations. It is suggested to amend to --a portion of the peripheral border of the inner surface of the panel is free of the grid pattern--, and to include a similar recitation in the Specification to provide for antecedent basis.

k. Claim 9, line 3 recites "the repair panel being flexible at ambient temperatures so as to conform to the shape of the lens or bulb housing." There is no support in the Specification for the repair panel being flexible at ambient temperatures and no suggestion to one of ordinary skill in the art that Applicant had possession of the panel being flexible at ambient temperatures to conform to the shape of the lens or bulb housing.

l. Claims 9 and 17 recite “ the panel may be flexed in situ”. There is no support in the original Specification that would suggest to one of ordinary skill in the art that Applicant had possession of the panel being flexed in situ.

m. Claim 12 recites, “the grid pattern of the second plurality being of different configurations than the grid pattern of the first plurality, whereby the portion of the panel having a grid pattern configuration most closely resembling that of the damaged area of the lens or bulb housing may be separated from the panel to provide a repair patch.” The original Specification discloses a repair panel with two sections of grid patterns in figures 1, 5, and 6, a selection of round cuts on page 7 and on pages 8-9 that a selected configuration of color and ridges for the deflection of light is selected and engaged over the break in a flat or curved surface. Consequently, Applicant only has support for multiple panels having differing configurations but not the same panel having portions with differing configurations of ridges. There is no support in the Specification for a panel having a two grid patterns of a different configurations, or separating a portion having a pattern configuration most closely resembling that of the damaged area of the lens or bulb housing from the panel.

n. Claim 13 recites, “multiple discrete pluralities of intersecting lines of ridges, each plurality forming a differently configured grid pattern on the inner surface.” As discussed above, there is no disclosure of differently configured grid patterns on the same panel in the original Specification.

o. Claim 17, line 3 recites “the panel being flexible at ambient temperatures”. There is no support in the Specification for the repair panel being flexible at ambient

temperatures and no suggestion to one of ordinary skill in the art that Applicant had possession of the panel being flexible at ambient temperatures.

p. Claims 21-26 recites, "A method of in situ repair". There is no support in the original Specification that would suggest to one of ordinary skill in the art that Applicant had possession of the repair being in situ.

q. Claim 21 recites a step of "registering the repair panel with the damaged area." The original Specification does not disclose or describe such a step. It is suggested to delete the step.

r. Claim 21 recites, "flexing the panel at ambient temperature to conform to the contour of the lens or bulb housing." There is no support in the Specification for the repair panel being flexible at ambient temperatures and no suggestion to one of ordinary skill in the art that Applicant had possession of the panel being flexible at ambient temperatures to conform to the shape of the lens or bulb housing.

s. Claim 23 recites, "selecting from a large panel having plurality of patterns, a portion having a pattern most closely resembling that of the lens or bulb housing and cutting the repair panel from the selected portion of the large panel." The original Specification discloses a repair panel with a selection of round cuts on page 7 and on pages 8-9 that a selected configuration of color and ridges for the deflection of light is selected and engaged over the break in a flat or curved surface. Consequently, Applicant only has support for multiple panels having differing configurations but not the same panel having portions with differing configurations of ridges. There is no support in the Specification for a large panel having plurality of patterns, or selecting a portion

having a pattern most closely resembling that of the lens or bulb housing from a large panel, or cutting the repair panel from such selected portion of the large panel.

t. Claim 26 is unclear by reciting "the step of adhering achieves an atmospheric seal." There is no disclosure in the Specification of providing an atmospheric seal or what an atmospheric seal is and there is no suggestion to one of ordinary skill in the art that Applicant had possession of forming such a seal with the adhering step.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 17 is unclear by reciting "having a substantially uniform thickness". It is unclear what the scope of the limitation encompasses. That is, how uniform is substantially uniform? It is suggested to delete this recitation.

10. Claims 9 and 17 are unclear by reciting, "suitable for withstanding external exposure to the atmosphere". It is unclear what the scope of the limitation encompasses. It is unclear how one of ordinary skill in the art would be able to determine the scope of what is "suitable" for exposure to the atmosphere or not.

11. Claim 9 and 17 are unclear by reciting, "a substantially flat inner surface." It is unclear how one of ordinary skill in the art would be able to determine the scope of what is "substantially flat" or not. It is suggested to delete this recitation.

12. Claim 17 is unclear by reciting, "a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto." The Specification discloses providing gaskets with adhesive layers around a periphery of a patch to form a border with release strips on each strip and a separate panel where an adhesive layer 48 is on the back of the panel covered with a release paper 47 (page 8). It is unclear which embodiment Applicant is referring to in the claims.

13. Claims 9 and 17 recite "the panel may be flexed in situ". It is unclear what applicant means by such limitation. There is no way for one of ordinary skill in the art to ascertain how close to the repair does the panel have to be capable of flexing in order to be flexed in situ.

14. Claims 21-26 recite, "A method of in situ repair". It is unclear what the Applicant intends by such a limitation. There is no way for one of ordinary skill in the art to ascertain the scope of an in situ repair as currently claimed.

15. Claim 21 recites a step of "registering the repair panel with the damaged area." It is unclear what the scope of the limitation of registering is because Applicant did not disclose or describe such a step in the original Specification. It is suggested to delete the step.

16. The term "large" in claims **22 and 23** is a relative term which renders the claim indefinite. The term "large" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is suggested to amend to --from a larger panel-- and --of the larger panel--.

Art Unit: 1733

17. Claim 24 is unclear by reciting, "the step of applying a translucent adhesive includes covering an area surrounding the periphery of the repair panel with adhesive." This limitation is unclear in that an area surrounding the periphery of a panel is an area outside of the panel. It is suggested to change "surrounding" to either --on-- or --along--.

18. Claim 26 is unclear by reciting "the step of adhering achieves an atmospheric seal." It is unclear what an atmospheric seal is and the scope of the claim is also unclear.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 9, 14-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II (Clear Star Products, Inc. 1996) in view of Marshall (US Patent No. 5,569,346) as further taken with Butt (US Patent No. 6,106,648).

As to claim 9, Lens Saver II discloses a kit capable of repairing a damaged area of a lens or bulb housing, the lens or bulb housing having an exterior surface, the kit comprising a translucent repair panel (grid deflector) formed of a single layer (the grid deflector is only one layer), the repair panel being flexible at ambient temperatures so as to conform to the shape of the lens or bulb housing (the grid deflector does not require heating for application to curved surfaces), a substantially flat inner surface (see figures), a plurality of intersecting lines (see figures), the lines forming a grid pattern on the inner surface (see figures), the kit further including a plurality of elongate gasket strips (adhesive gaskets) of sufficient total length to overlie a peripheral border of the inner surface (see figures), each gasket strip including an adhesive layer covered by a release sheet (paper backings), the panel is capable of being flexed in situ to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area after application of gasket strips to the border and removal of the release sheets (see disclosure on page 2 for curved or contoured housings, the grid deflector is applied to a contoured lens) and capable of being sealed along the peripheral border to the exterior surface of the lens or bulb housing (see steps 8-10).

As to claim 17, Lens Saver II discloses a patch for repairing a damaged area of a lens or bulb housing, the lens or bulb housing having an exterior surface, the patch comprising a translucent repair panel (grid deflector) formed of a single layer (the grid

Art Unit: 1733

deflector is of only one layer), the panel being flexible at ambient temperatures (the grid deflector is able to be applied to curved surfaces without boiling), having a substantially uniform thickness (see figures) and a substantially flat inner surface (see figures), a plurality of intersecting lines (see figures), the lines forming a grid pattern (see figures), the panel being of a size sufficient to overlap the damaged area (step 6), the panel including a periphery, a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto (the adhesive gasket covers the entire periphery of the panel), whereby the panel is capable of being flexed in situ to conform to the contour of the exterior surface of the lens or bulb housing surrounding the damaged area and sealed to the exterior surface of the lens or bulb housing by applying a compressive force to the outer surface of the panel (the grid deflector is capable of bending to the shape of a curved lens, it is sealed to the exterior of the lens, and a compressive force is applied to the outer surface of the panel).

As to both claims 9 and 17, the limitation that the repair panel including an outer surface suitable for withstanding external exposure to the atmosphere, the grid deflector in Lens Saver II is considered to be suitable for external exposure to the atmosphere (as it is not applied in a vacuum). (It is noted that these limitations were not described in the original Specification and it is unclear what the scope of the limitations of the suitability of the panel is). Optionally, Marshall discloses a similar repair panel grid deflector known in the art (patterned plastic) that is of the same plastic material as that used for the outer layer (thermoplastic patch) which is also assumed to have the suitable properties for withstanding external exposure to the atmosphere and therefore

Art Unit: 1733

it is considered that the patterned plastic is also suitable for withstanding external exposure to the atmosphere. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector as shown in Lens Saver II of known materials in the art as exemplified by Marshall. Only the expected results would be attained.

As to both claims 9 and 17, the limitation that ridges extend from the inner surface toward the outer surface, Lens Saver II does not specifically disclose the manner of providing the grid on the grid deflector. Marshall shows that it is known in the art to provide grid patterns on grid deflectors by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges extending from the inner surface toward the outer surface. It is well known to provide lenses and in particular repair patches for lenses with ridges extending into the thickness of the panel from the inner surface toward the outer surface to forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has a patterned inner surface that is flat with ridges extending into the thickness of the panel from the inner surface toward the outer surface that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Lens Saver with a pattern by tooling as shown in Marshall where the pattern of ridges extending from the inner surface toward the outer surface in order to form a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

As to claims 14 and 18, Lens Saver II does not specify whether the adhesive layer is translucent. However, it is well known in the repair art of lenses to provide translucent adhesive in order to maintain the translucency of the lens. For example, Marshall discloses the known repairs are translucent and it is desired in this art to provide a translucent repair including using translucent adhesives (column 1, lines 1-45; column 3, lines 59-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer as shown in Lens Saver II that is translucent as is considered well known in the repair art for repairing lens parts and further exemplified by Marshall in order to provide a translucent repaired product.

As to claim 15, the grid pattern in Lens Saver II appears to be of a first and second plurality of equidistantly spaced parallel lines that are perpendicular to each other (see figures). Furthermore, it is well known in the art to provide such a grid pattern to repair parts for repairing lens products (see the examples of known patterns in Butt). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector in Lens Saver II with well known grid patterns as exemplified by Butt in order to match the lens or bulb housing to be repaired, only the expected results would be attained.

As to claims 16 and 20, Lens Saver II does not specifically recite the colors of the repair panel (grid deflector). It is well known in the art to provide grid deflectors from the typical colors of the lens products to be repairs such as amber or red. For example, Marshall discloses providing colorant or dye to the plastic in patterned repair panels (patterned plastic) in a variety of colors including amber and red in order to match the

Art Unit: 1733

color of the lens (column 2, lines 40-52 and column 3, lines 11-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector of Lens Saver II that bear the colors amber or red as is considered well known in the art in order to match the grid deflector to the damaged lens or bulb housing color and as further exemplified by Marshall.

22. Claims 10-13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II in view of Marshall as taken with Butt as applied to claims 9, 17 above, and further in view of Boyce (US Patent No. 2,833,327).

As to claims 11 and 19, it is unclear whether the repair panel in Lens Saver II has a border surrounding the periphery that is free of the grid pattern. It is noted that the last figure on the first page appears to show a border around the panel. Additionally, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide a border free from the grid pattern as a design choice of one of ordinary skill in the art. Only the expected results would be attained. Furthermore as to both claims 10 and 19, it is well known in the repair art to provide a repair patch from a repair panel that includes multiple patches for repair in order to give the customer choice in the size or shape of repair. For example, as to claim 10, Boyce discloses borders that separate the panel into two segments of different shapes and sizes where one segment is larger than another and the panel is cut along the portion or border to provide differently sized patches. As to claim 19, Boyce discloses a repair panel that provides plural repair patches separated by borders around the peripheries of the patches (column 1, lines 55-60; column 3, lines 4-38). It would have been obvious to

Art Unit: 1733

one of ordinary skill in the art at the time of the invention to provide the grid deflector in Lens Saver II with a border around the individual patches free of the grid pattern in order to provide the user with multiple repair patches as is considered well known in the repair art and further exemplified by Boyce. Only the expected results would be attained.

As to claim 12, as discussed above, the panel in Boyce is separated by borders to provide patches of different shapes and sizes. It is also considered well known in the art to have differing grid patterns for different lens or bulb housings. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a grid deflector panel with multiple patches of different sizes and/or configurations of grid patterns on each of the patches in order to provide appropriate patches for the different types of lens and bulb housings to be repaired. Only the expected results would be attained. As to claim 13, as discussed above, Boyce discloses providing repair panels with multiple, discrete sized patches. It is also considered well known in the art to have differing grid patterns for different lens or bulb housings. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a grid deflector panel with multiple discrete patches of different sizes and/or configurations of grid patterns on each of the patches in order to provide appropriate patches for the different types of lens and bulb housings to be repaired. Only the expected results would be attained.

23. Claims 21, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II (Clear Star Products, Inc. 1996) in view of Marshall (US Patent No. 5,569,346).

Lens Saver II discloses a method of in situ repair of a damaged area of a lens or bulb housing by obtaining a flexible translucent repair panel (clear plastic grid deflector) formed of a single layer and having a size sufficient to overly the damage area (see figures), applying an adhesive to at least a portion of an inner surface of the repair panel (adhesive gaskets), registering the repair panel with the damaged area (the grid deflector is placed over the damaged area), flexing the panel at ambient temperature to conform to the contour of the lens or bulb housing (the grid deflector conforms to the shape of the lens or bulb housing without heating), and adhering the periphery of the inner surface of the repair panel to the exterior surface of the lens or bulb housing (step 10).

As to the repair panel being flexible, the grid deflector in Lens Saver II is considered to be flexible as it is used to cover damaged areas in curved lenses, therefore it is flexible enough to be curved to the shape of the lens. Additionally, Marshall discloses known materials for forming grid deflectors (patterned plastic) which are also considered to be flexible (considering their materials and thickness). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector in Lens Saver II as a flexible panel as is considered known in the art as exemplified by Marshall in order to conform to the curved shape of the lens product.

Lens Saver II does not specify whether the adhesive layer is translucent. However, it is well known in the repair art of lenses to provide translucent adhesive in order to maintain the translucency of the lens. For example, Marshall discloses the known repairs are translucent and it is desired in this art to provide a translucent repair including using translucent adhesives (column 1, lines 1-45; column 3, lines 59-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer as shown in Lens Saver II that is translucent as is considered well known in the repair art for repairing lens parts and further exemplified by Marshall in order to provide a translucent repaired product.

As to claim 22, the grid deflector in Lens Saver II is obtained by cutting from a larger panel (step 6). As to claim 24, the adhesive covers the entire panel therefore the step of applying adhesive in Lens Saver II reads on covering an area surrounding the periphery of the panel with adhesive.

As to claim 25, Lens Saver II does not specifically recite the colors of the repair panel (grid deflector) or the lens or bulb housing. It is considered well known in the art that lens or bulb housings are colored and to provide grid deflectors from the typical colors of the lens products in order to be repaired. For example, Marshall discloses providing colorant or dye to the plastic in patterned repair panels (patterned plastic) in a variety of colors including amber and red in order to match the color of the lens (column 2, lines 40-52 and column 3, lines 11-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of Lens Saver II by providing multiple grid deflectors that bear multiple colors corresponding to the

Art Unit: 1733

multiple colors of lens and bulb housings that are available as is considered well known in the art in order to match the grid deflector to the damaged lens or bulb housing color and as further exemplified by Marshall.

As to claim 26, the adhered grid deflector is considered to form a seal similar to Applicants, therefore it is considered to be an "atmospheric seal" (see discussion above as to how this limitation is new matter and unclear).

24. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II in view of Marshall as applied to claim 21 above, and further in view of Boyce (US Patent No. 2,833,327).

Lens Saver II discloses the grid deflector has a plurality of lines forming a pattern (see figures). It is unclear whether the lines are ridges, however it is considered well known in the art to form grid patterns on grid deflectors with ridges. Additionally, Marshall shows that it is known in the art to provide grid patterns on grid deflectors by tooling (column 3, lines 25-28). The tooled pattern is considered to form ridges. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of repair as shown in Lens Saver II with a grid deflector pattern that forms ridges as is considered well known in the art and further exemplified by Marshall in order to closely resemble the lens or bulb housing being repaired.

As to the limitation that the panel is selected from a large panel having a plurality of patterns and where the pattern most closely resembling the lens or bulb housing being repaired is selected and the repair panel is cut from that selected portion, such is considered well within the purview of one of ordinary skill in the art. Additionally, it is

Art Unit: 1733

well known in the repair art to provide a repair patch from a repair panel that includes multiple patches for repair in order to give the customer choice in the size and/or shape of repair. For example, Boyce discloses it is known in the repair art to provide panels for cutting out patches for repair with areas of different shapes and cutting between the areas to provide differently sized/shaped patches. It is also considered well known in the art to have differing grid patterns for different lens or bulb housings. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a grid deflector panel with multiple areas or patches of different sizes and/or grid patterns on each of the patches in order to provide appropriate patches for the different types of lens and bulb housings to be repaired. Only the expected results would be attained. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of repair as shown by Lens Saver II where a large panel is provided with a plurality of patterns and the pattern most closely resembling the lens or bulb housing to be repaired is used to cut the repair panel as is considered well known in the art to provide lens and bulb housings with differing patterns and it is also known in the art to provide large panels with differing patches as shown by Boyce in order to provide repair patches that are suitable for multiple types of lens and bulb housings. Only the expected results would be attained.

Response to Arguments

25. Applicant's arguments filed May 13, 2004 have been fully considered but they are not persuasive.

Applicant argues on page 10 that the Lens Saver II is not flexible at ambient temperatures and requires heating which is difficult to achieve in situ. It is noted that the rejections are based upon the grid deflector panel in Lens Saver II which does not require heating in order to conform to curved surfaces.


Applicant argues that the Lens Saver II does not comprise a repair panel of a single layer. It is noted that the rejections are based upon the grid deflector panel in Lens Saver II which is a single layer panel. The claims do not exclude applying additional layers to the grid deflector after application to the damaged area.

Applicant also argues that the Marshall reference discloses a two part laminated patch which requires heating in boiling water. The Marshall references is only relied upon for showing properties of grid deflectors in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.


Gladys JP Corcoran
Primary Examiner
Art Unit 1733

GJPC
September 2, 2004